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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,989

03/31/2004

Roy K. Greenberg

8627-372

8184

757 7590 06/03/2008  
BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610

EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/814,989	<b>Applicant(s)</b> GREENBERG ET AL.	
	<b>Examiner</b> Pedro Philogene	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 1-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e)—or—120-- as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/003,011, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Applicant fails to provide adequate disclosure in the prior application for a "retraction mechanism that biases the actuation section and hence the grasping portion towards a retracted states". Since, the drawings and specification of application No. 10/814,989, are the original presentation of a retraction mechanism that biases the actuation section and hence the grasping portion towards a retracted states, applicant's claim for benefit is 3/31/2004, the filing date of the 10/814,989 application. Accordingly, claims 1-22 are not entitled to the benefit of the prior application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates (5,944,728) in view of Teague et al. (7,322,989)

With respect to claims 1, 23, Bates disclose a medical grasping device comprising: an elongate control member (23) having an atraumatic distal tip section (22), as best seen in FIG.1, and a proximal end portion; the elongate control member further including a grasping portion (16) proximal the distal tip section; an outer sheath (14) with a passageway therethrough, as best seen in FIG.1, surrounding the elongate control member and relatively movable with respect thereto.

Although Bates teaches of an actuation section, as set forth in column 4, lines 1-67, it is noted that Bates, did not teach of an actuation section, as claimed by applicant. However, in a similar art, Teague et al., column 6, lines 38-42; column 7, lines 1-63; column 8, lines 12-25; provide the evidence of such an actuation section with retraction mechanism that biases the actuation section proximally causing a relative motion between the elongate control member and the sheath urging the grasping portion towards a retracted state to enable the control deployment and displacement of a device.

Therefore, given the teaching of Teague et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the actuation

mechanism, as taught by Teague et al, in the device of Bates, to bias the actuation section to enable the control deployment and displacement of the grasping portion.

Furthermore, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385,1396 (2007). Therefore, it would have been obvious to try an actuation section, as taught by Teague et al., in order to bias the actuation section and hence the grasping portion towards a retracted state.

With respect to claims 2-11, the above combination of references teaches all the limitations, as set forth in Bates, column 3, lines 45-67, column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-61 and as best seen in FIGS.1-7; also as set forth in Teague et al, column 6, lines 38-42, column 7, lines 1-63, column 8, lines 12-25; and as best seen in FIGS.8-11.

Claims 12-22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Bates (5,944,728) in view of Teague et al (7,322,989) in view of Hillstead (5,098,440).

With respect to claims 12-22, it is noted that the above combination of references teaches all the limitations, except for wire loops that are substantially circular upon full deployment, as claimed by applicant. However, in a similar art, Hillstead evidences the use of wire loops that are circular upon full deployment and having side sections that

overlap and touch the vessel wall to engage the object to be retrieved with a greater force.

Therefore, given the teaching of Hillstead, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to incorporate the design of the grasping device of Hillstead in the grasping device of Bates/Teague et al. to engage the object to be retrieved with a greater force.

### ***Response to Amendment***

Applicant's arguments, see Remarks, filed 2/29/08, with respect to the rejection(s) of claim(s) 1-23 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Teague et al. The examiner agrees with applicant, Hogendijk does not teach of an actuation section proximally causing a relative motion between the elongate control member and the sheath urging the grasping portion towards a retracted state. However, in similar art, Teague et al provides the evidence of the use of a actuation mechanism that biases the actuation section proximally causing a relative motion between the elongate control member and the sheath (58) urging the grasping portion (62) towards a retracted state; As set forth in column 6, lines 38-42, column 7, lines 1-63, column 8, lines 12-25 and as best seen in FIGS.8-11 of Teague et al. Therefore, a combination of Teague et al with the device of Bates et al to arrive at applicant's claimed invention would have been obvious to one having ordinary skill in the art. Since applicant amended the claims, this action is made final.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
May 30, 2008